

### REMARKS

In an Office action mailed on April 18, 2007, the Examiner considered pending claims 21-40, following which:

- (1) A potential priority claim to International Application No. PCT/IB03/04872 (filed October 31, 2003) is discussed;
- (2) Claims 21, 26, and 31-35 stand objected to;
- (3) Claims 21-40 stand rejected under 35 U.S.C. § 112, para. 2;
- (4) Claims 21-23, 28, 30, and 36 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,936,071 to Marnay et al. ("Marnay");
- (5) Claims 21, 27, and 29-36 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Pub. No. 2004/0243240 to Beaurain et al. ("Beaurain");
- (6) Claims 21, 37, 39, and 40 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Pub. No. 2006/122703 to Aebi et al. ("Aebi");
- (7) Claim 24 stands rejected to under 35 U.S.C. § 103(a) as being unpatentable over Marnay in view of U.S. Patent No. 6,419,706 to Graf ("Graf");
- (8) Claim 25 stands rejected to under 35 U.S.C. § 103(a) as being unpatentable over Marnay in view of Graf and further in view of U.S. Patent No. 6,899,735 to Coates et al. ("Coates"); and
- (9) Claim 38 stands rejected to under 35 U.S.C. § 103(a) as being unpatentable over Aebi.

A Preliminary Amendment was filed in this case on April 17, 2007, prior to the mailing of the Office action. Claims 41-64 submitted in the Preliminary Amendment were not considered in the Office action. The **Complete Listing of Claims** of this paper, however, reflects the claims as standing in the application after entry of the April 17, 2007, Preliminary Amendment.

#### ***Request for Correction of Office's Records***

It is noted that the Bibliographic Data Sheets entered by the Office in this case do not reflect that Jean Huppert is an inventor, and further that the U.S. publication of this application

(US 2006/0155377 A1) similarly omits naming Jean Huppert as an inventor. It is respectfully submitted that the omissions are the result of error by the Office, as all of the following documents entered in the record of this application name Jean Huppert as an inventor: International Application No. PCT/IB03/04872 (which entered the national stage in the United States as the present application); the certified copy of the French priority application, FR 0213833; the Declaration and Power of Attorney filed November 11, 2005, and the Response to the notification of missing requirements also filed November 11, 2005. Accordingly, it is respectfully requested that the Office correct its records in this case to include Jean Huppert as an inventor.

**(1) *Priority Claim***

The Office action discusses a potential priority claim to International Application No. PCT/IB03/04872, filed October 31, 2003 (referred to herein as "IA 04872"). The Office action correctly notes that the present application claims subject matter disclosed in IA 04872. However, no priority claim to IA 04872 is necessary, as the present application is a national stage application of IA 04872. *E.g.*, MPEP § 1893.03(c) ("[A] national stage application submitted under 35 U.S.C. 371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the date of filing of that international application.").

In addition, priority to French application FR 0213833, filed November 5, 2002, was properly claimed in the international stage of IA 04872, and the file of the present application contains a copy of the certified copy of the priority document submitted to the International Bureau in IA 04872. Thus, all requirements for the claim of priority to French application FR 0213833 have been satisfied pursuant to 35 U.S.C. §§ 365(b) and 119(a), 37 C.F.R. § 1.55(a), and MPEP § 1893.03(c). Accordingly, the claim for priority to FR 0213833 should be acknowledged and made of record in this case.

**(2) *Objection to Claims 21, 26, and 31-35***

Claims 21, 26, and 31-35 stand objected to due to informalities. Claim 21 has been amended by this paper as indicated by the Examiner, thus addressing the basis for objection to claim 21. Amendments of claims 26, 31, and 33-35 in the Preliminary Amendment have already addressed the basis for the objection to claims 26 and 31-35. Accordingly, withdrawal of the objections to claims 21, 26, and 31-35 is respectfully requested.

**(3) *Rejection of Claims 21-40 Under 35 U.S.C. § 112, Para. 2***

Claims 21-40 stand rejected under 35 U.S.C. § 112, para. 2. Amendment of claim 21 in the Preliminary Amendment has already addressed the basis for the rejection of claim 21-40 based on the lack of antecedent basis for the term “planes.” Claims 29 and 30 have been amended by this paper to depend from any one of claims 22 or 23, thus addressing the bases of the rejections of claims 29 and 30. Accordingly, withdrawal of the rejections of claims 21-40 is respectfully requested.

**(4) *Rejections Based on Marnay***

Claims 21-23, 28, 30, and 36 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Marnay. The issue date of Marnay, however, is August 30, 2005. Thus, Marnay cannot be prior art under 35 U.S.C. § 102(b) for the present application, which entered the national stage in the United States on May 4, 2005.

It is noted, however, that PCT Publication No. WO 01/01893 was published on January 11, 2001, as the PCT publication for the international application for which Marnay is the national stage entry in the United States. To moot any future rejection based on PCT Publication No. WO 01/01893, it is noted that claim 21 now recites “the core being movable in translation and rotation with respect to the lower plate.” In addition, claim 41 recites “the lower plate being configured for translation movements of the core with respect to the lower plate along an axis substantially parallel to the upper surface of the lower plate and for rotation movements of the core with respect to the lower plate around an axis substantially perpendicular to the upper surface of the lower plate,” and claim 56 recites “the lower plate being configured for translation

movements of the core with respect to the lower plate along an axis substantially parallel to the lower plate and for rotation movements of the core with respect to the upper surface of the lower plate around an axis substantially perpendicular to the upper surface of the lower plate.”

In Marnay, during implantation the lower part (3) and pivot insert (4) are fixed immovably together into a unitary structure:

*The outer dimensions of the platelike pivot insert correspond to those of the central indentation 19 in the lower part 3, so that the pivot insert 4 can be thrust into this indentation, filling it up . . . .*

Guide strips 26 on the side edges of the pivot insert 4 engage corresponding guide grooves 27 in the legs 16, 17, so that an insertion guide for the pivot insert 4 is formed that *fixes it* in the lower part 3 after its insertion. The inserted pivot insert 4, after insertion, *fills up the indentation 19 . . . .*

. . . .

The pivot insert 4 can have a *detent protrusion 28* on its flat underside 24; when the pivot insert 4 is inserted into the lower part 3, this protrusion *locks elastically into a detent recess 29* that is located on the bottom of the indentation 19; as a result, the pivot insert 4 is also *fixed* in the insertion direction in the indentation 19.

Marnay, col. 5, lines 11 – 14, 28 – 33 (emphasis added). Thus, Marnay discloses only a pivot insert and a lower part fixed immovably together. Accordingly, Marnay does not teach or suggest the configuration of the lower plate and core recited in claims 21, 41, and 56 of the present application.

Because Marnay and its PCT publication do not teach or suggest all of the elements of claims 21, 41, and 56, those claims and their respective dependent claims are not anticipated by Marnay or its PCT publication. *E.g.*, MPEP § 2131; *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987) (both stating that for a claim to be anticipated, each and every element

of the claim must be present, either expressly or inherently, in a single prior art reference);  
35 U.S.C. § 112 ¶ 4. The withdrawal of the rejections based on Marnay is respectfully requested.

**(5) *Rejections Based on Beaurain***

Claims 21, 27, and 29 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Beaurain. The earliest possible 102(e) date of Beaurain is its international filing date of May 3, 2003. *See, e.g.*, MPEP § 706.02(f)(1). As noted in section (1) above, however, all requirements for the claim of priority to French application FR 0213833 have been satisfied pursuant to 35 U.S.C. §§ 365(b) and 119(a), 37 C.F.R. § 1.55(a), and MPEP § 1893.03(c). FR 0213833 was filed on November 5, 2002, thus rendering Beaurain inapplicable as prior art under 35 U.S.C. § 102(e). To perfect the priority claim to FR 0213833 to overcome the rejection based on Beaurain, a translation of the certified copy of FR 0213833 is submitted with this paper to be made of record in accordance with 37 C.F.R. § 1.55 and MPEP § 201.15, together with a statement that this translation of the certified copy of FR 0213833 is accurate. Accordingly, withdrawal of the rejections based on Beaurain is respectfully requested.

**(6) *Rejections Based on Aebi***

Claims 21, 37, 39, and 40 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Aebi. The earliest possible 102(e) date of Aebi is its international filing date of December 17, 2002. *See, e.g.*, MPEP § 706.02(f)(1). Thus, for the reasons noted in section (5) above, Aebi is inapplicable as prior art under 35 U.S.C. § 102(e), and withdrawal of the rejections based on Aebi is respectfully requested.

**(7) *Rejection Based on Marnay in View of Graf***

Claim 24 stands rejected to under 35 U.S.C. § 103(a) as being unpatentable over Marnay in view of Graf. Graf does not cure the defects of Marnay noted in section (4) above. Accordingly, withdrawal of the rejection based on Marnay in view of Graf is respectfully requested.

**(8) *Rejection Based on Marnay in View of Graf and Further in View of Coates***

Claim 25 stands rejected to under 35 U.S.C. § 103(a) as being unpatentable over Marnay in view of Graf and further in view of Coates. Graf and Coates do not cure the defects of Marnay noted in section (4) above. Accordingly, withdrawal of the rejection based on Marnay in view of Graf and further in view of Coates is respectfully requested.

**(9) *Rejection Based on Aebi***

Claim 38 stands rejected to under 35 U.S.C. § 103(a) as being unpatentable over Aebi. As noted in section (6) above, Aebi is not prior art to the present application. Accordingly, withdrawal of the Section 103 rejection based on Aebi is respectfully requested.

***Conclusion***

In view of the reasons given above, reconsideration of the pending application and the timely allowance of pending claims 21-64 is respectfully requested. It is believed that this paper addresses all of the rejected claims and other matters sufficiently to support the allowance of all of the pending claims. If the Examiner has any remaining concerns, the courtesy of a telephone interview with the undersigned is respectfully requested.

The April 18, 2007, Office action contains a number of statements potentially reflecting characterizations of various claims, supporting descriptions, and/or patent or patent application references, but regardless of whether any such statements are addressed in this response, the Principal (as defined in 37 C.F.R. § 1.32(a)(3)) declines to automatically subscribe to any statement or characterization in the Office action. Although the Examiner's rejection of claims 21-40 has been traversed as set forth above without reference to many of such statements, all rights to dispute statements regarding such rejections later in any subsequent applications or causes of action relating to this application or any other application are expressly reserved. Accordingly, the absence of a reply to a specific rejection, issue, or comment does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reason for patentability of any or all

Applicant : Beaurain et al.  
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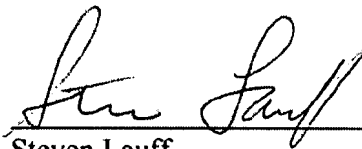
Attorney's Docket No.: 21249-014US1 – LDR/10/US

pending claims (or other claims) that have not been expressed. Nothing in this paper should be construed as conceding any issue with regard to any claim except as specifically and expressly stated in this paper, and the amendment of any claim should not be construed as conceding the unpatentability of the claim prior to amendment except as specifically and expressly stated in this paper.

The Commissioner is hereby authorized by this written request to treat this or any concurrent or future reply that requires a petition for an extension of time under 37 C.F.R. § 1.136(a) for its timely submission as incorporating a petition for extension of time for the appropriate length of time. The Commissioner is further authorized to charge all required fees, including without limitation excess claim fees or other fees under 37 C.F.R. § 1.16 or any required extension of time fees or other fees under 37 C.F.R. § 1.17, to Deposit Account No. 06-1050, on which the undersigned is authorized to sign, and to treat such authorization to charge Deposit Account No. 06-1050 as a constructive petition for an extension of time in this or any concurrent or future reply requiring a petition for an extension of time under 37 C.F.R. § 1.136(a) for its timely submission. The Commissioner is further hereby authorized to credit any overpayment to Deposit Account No. 06-1050.

Please direct all correspondence in this application to **PTO CUSTOMER NO: 26201**.

Respectfully submitted,



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Date: October 16, 2007

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